



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the application of:

Confirmation No.: 6903

Del Soldato *et al.*

Group Art Unit: Unknown

Application Serial No.: 10/577,912

Examiner: Not Yet Assigned

Filed: May 1, 2006

Attorney Docket No.: 026220-00082

For: NITROOXYDERIVATIVES OF CARVEDILOL AND OTHER BETA BLOCKERS
AS ANTIHYPERTENSIVE DRUGSPETITION UNDER 37 C.F.R. § 1.47(a)**Mail Stop PETITIONS**

July 19, 2006

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Pursuant to 37 C.F.R. § 1.47, the applicants respectfully petition the U.S. Patent and Trademark Office to accept the Oath/Declaration and Assignment submitted herewith containing the signatures of inventors Francesca BENEDINI and Ennio ONGINI. The signature of Piero DEL SOLDATO is missing from the Oath/Declaration and Assignment, as he refuses to join in the application (Piero DEL SOLDATO is a non-signing inventor). Pursuant to 37 C.F.R. § 1.47 and M.P.E.P. § 409.03, the applicants include:

- 1) an affidavit by Italian attorney Maria Teresa Noro indicating that she sent the entire application (specification, claims, and drawings) along with a declaration to inventor Del Soldato twice requesting his signature on the declaration. On neither occasion did inventor Del Soldato return the signed declaration nor did he ever indicate that he was willing to participate in this application;
- 2) letters sent by Attorney Noro; and
- 3) copies of postal receipts.

07/24/2006 MKAYPAGH 00000063 10577912

01 FC:1464
02 FC:2617130.00 OP
65.00 OP

TECH/416047.1

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The last known address of inventor Piero DEL SOLDATO, is:

Via Enrico Toti 22
Monza, MI 20052
ITALY

Applicants respectfully submit that the affidavit by Italian attorney Maria Teresa Noro is sufficient evidence of receipt of the complete copy of the application papers to the non-signing inventor in accordance with the requirements of the Manual of Patent Examining Procedure (M.P.E.P.) § 409.03(d). M.P.E.P. § 409.03(d) specifically permits the applicants to present a copy of the application papers *to the address of the nonsigning inventor's attorney if the nonsigning inventor is represented by counsel*. Inventor Del Soldato clearly is represented by counsel, namely Mr. Fabrizio Conte. The affidavit by Italian attorney Maria Teresa Noro indicated that she sent the entire application (specification, claims, and drawings) along with a declaration twice to inventor Del Soldato and to his counsel, Mr. Conte, requesting his signature on the declaration (see enclosed affidavit by Attorney Teresa Noro). On both occasions Mr. Conte acknowledged receipt of the information - the notation *ricevuta* (received), the signature, and the date at the bottom of both letters clearly showed that Mr. Conte received both sets of documents. For the record, Mr. Conte acknowledged receiving the first letter on May 16, 2006 and the second letter on June 1, 2006.

In particular, Applicants note that the May 16, 2006 and June 1, 2006 specifically disclose the following paragraph:

1) ns. rif. NP 0015 dal titolo "NITROOXYDERATIVES OF CARVEDILOL AND OTHER BETA BLOCKERS AD ANTIHYPERTENSIVE DRUGS" – 5 Documenti:
Canada/Assignment; New Zealand/Request under Section 23(3);
USA/Assignment e Declaration; South Africa/Assignment e il test del brevetto [text of the patent].

(emphasis added). Further, the fourth full paragraph on page 1 of the Affidavit of Maria Teresa Noro discloses the following:



ns. rif. NP0015 dal titolo "NITROOXYDERATIVES OF CARVEDILOL AND OTHER BETA BLOCKERS AD ANTIHYPERTENSIVE DRUGS" – 5 Documents:
Canada/Assignment; New Zealand/Request under Section 23 (3);
USA/Assignment e Declaration; South Africa/Assignment and
invention patent text.

(emphasis added).

Applicants submit that NP0015, as well as the above disclosed title, specifically references the above-identified patent application, such that the 'Affidavit' and the supporting documentation clearly establishes that the documents sent to Piero DEL SOLDATO relate to the instant application number. In fact, Applicants note that "NP0015" is cited as Applicant's reference number throughout the previously filed documents of the related PCT Application. As such, Applicants submit that the previously submitted Affidavit of Maria Teresa Noro and the accompanying documents are sufficient factual proof of Piero DEL SOLDATO's refusal to execute the above-identified patent application or that he cannot be reached after diligent effort.

By delivering the entire application to the non-signing inventor's counsel—not once but twice—the applicants respectfully submit that have fully complied with the procedures set forth in M.P.E.P. §409.03(d). The non-signing inventor's counsel is legally obligated to inform the non-signing inventor of the receipt of these documents. In other words, by delivering the entire application to the non-signing inventor's counsel the applicants have made a *bona fide* attempt to comply with the provisions of 37 C.F.R. §1.47(a) and have established that the non-signing inventor received all the application materials.

The non-signing inventor's counsel is also in the best position to ascertain the non-signing inventor's intent. Inventor Del Soldato and his counsel were provided all the application materials and have not joined the application, despite being given several opportunities to do so. Inventor Del Soldato conduct is clear evidence that he does not intend to join and must therefore be declared a non-signing inventor.

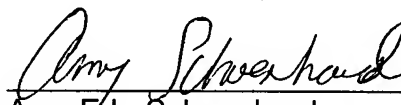
The applicants respectfully submit that they have made a *bona fide* attempt to comply with the provisions of 37 C.F.R. § 1.47. The applicants respectfully request the

Application Serial No.: 10/577,912
Inventor(s): Del Soldato *et al.*
Attorney Docket No.: 026220-00082

Office of Petitions grant this petition and forward the file to the Office of Initial Patent Examination (OIPE) for further processing. If any questions or issues remain, the Office of Petitions is respectfully requested to contact the undersigned to help with their resolution.

The applicants include a check for \$195.00 containing \$130.00, the petition fee under 37 C.F.R. § 1.17(h), and \$65.00, the surcharge for the late oath/declaration. If the Petition is not timely filed, the applicants hereby petition for an appropriate extension of time. The Commissioner is authorized to charge any additional fees or credit any over-payments to Deposit Account No. 01-2300, referencing Attorney Docket No. 026220-00082.

Respectfully submitted,
ARENT FOX PLLC



Amy E.L. Schoenhard
Registration No.: 46,512

Customer No.: **004372**
1050 Connecticut Avenue, N.W.
Washington, D.C. 20036-5339
Telephone No.: 202-857-6000
Facsimile No.: 202-857-6395

Avv. Maria Teresa Noro

Spettabile
NicOx Research Institute Srl
Giovanna Barchielli
Via Ariosto 21
20091 - BRESSO
(Milano)



*Viale Regina Margherita 41
20122 Milano
Tel. 02.550.111.99
Fax 02.55.16.369*

Milan, June 28, 2006

AFFIDAVIT

I, the undersigned Maria Teresa Noro, lawyer, practising in Milan, Viale Regina Margherita 41, state the following.

I have been requested by Nicox to assist it in its controversy against Mr. Piero del Soldato, a shareholder of the company Nicox S.A. and employee of Nicox S.r.l. who was dismissed by letter dated April 2, 2004.

On April 6, Mr. Piero Del Soldato challenged his dismissal and enforced his alleged right to be granted certain sums as compensation for his being assigned to less qualified duties, as well as the bonus under Articles 23 and following of Royal Decree no. 1127/39 (the Italian Patent Law) on account of the inventions of which he has been designated inventor or co-inventor during his employment relationship and which remains the sole property of N. SA. For this reason, in the past few months I have been in touch on a frequent basis with Mr. Fabrizio Conte of the Milan Bar, the lawyer who is assisting Mr. Piero Del Soldato in the above mentioned controversy.

On May 8, 2006 Nicox S.A.'s Legal Department asked me to have the following documents signed by Mr. Piero Del Soldato and returned to it:

- ns. rif. NP 0015 dal titolo "NITROOXYDERATIVES OF CARVEDILOL AND OTHER BETA BLOCKERS AD ANTIHYPERTENSIVE DRUGS" – 5 Documents: Canada/Assignment; New Zealand/Request under Section 23 (3); USA/Assignment e Declaration; South Africa/Assignment and invention patent text.

On May 9, 2006 I sent set of the above mentioned documents to Mr. Piero Del Soldato, at his domicile in Monza, Via Enrico Toti 22, with copy hand-delivered to his lawyer, asking Mr. Piero Del Soldato to return said documents to me duly signed within eight days of receipt of same.

Avv. Maria Teresa Noro

Mr. Conte and Mr. Piero Del Soldato have never returned me the above mentioned documents attached to my letter of May 9, 2006 and have failed to provide any written explanation of the reasons why Mr. Piero del Soldato refused to sign them.

On May 25, 2006 I sent another set of the above mentioned documents to Mr. Piero Del Soldato, at his domicile in Monza, Via Enrico Toti 22, with another copy hand-delivered to his lawyer, asking Mr. Piero Del Soldato to return said documents to me duly signed within eight days of receipt of same.

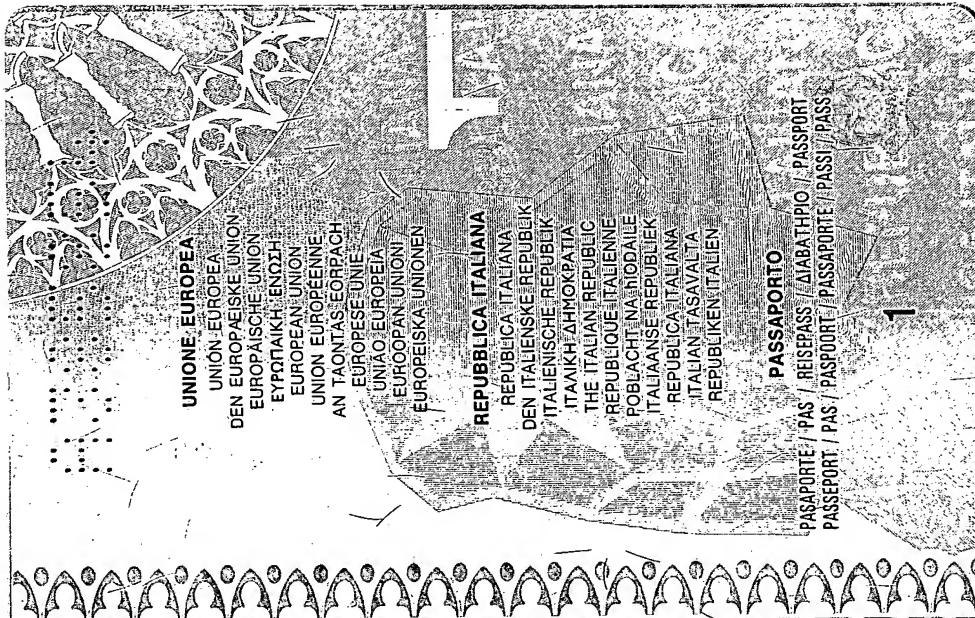
Mr. Conte and Mr. Piero Del Soldato have never returned me the above mentioned documents attached to my letter of May 25, 2006 and have failed to provide any written explanation of the reasons why Mr. Piero del Soldato refused to sign them.

I enclose herewith copies of my letters dated May 9, 2006 and May 25, 2006, together with the related registered mail receipt and acknowledgement of receipt signed by Mr. Del Soldato and also the copies signed by Mr. Conte.

A copy of my passport is also enclosed.

Respectfully submitted,

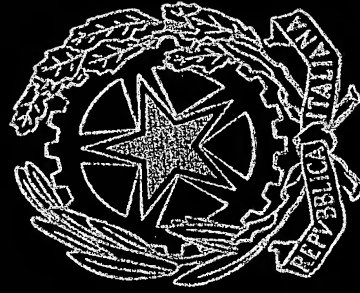

(Avv. Maria Teresa Noro)



IL QUESTORE DI MILANO

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REPUBBLICA ITALIANA



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TO GJ 1985 MILAN/MAL

Avv. Maria Teresa Noro

Egregio Signor
dott. Piero del Soldato
Via Enrico Toti 22
MONZA

*Viale Regina Margherita 51
20122 - Milano
Tel. 02.550.949.99
Fax 02.55.98.989*

e, per conoscenza
RACCOMANDATA A MANO
Egregio Signor
Avvocato Fabrizio Conte
Via Freguglia 8/a
20122 - MILANO

Milano, 9 maggio 2006
RACCOMANDATA A.R.

Egregio dott. Del Soldato,

Le trasmetto qui unita la documentazione testé trasmessami dalla Direzione Brevetti di Nicox, la quale mi ha incaricato di contattarLa per richiederLe di sottoscriverla.

Si tratta, specificamente, della seguente documentazione:

- 1) ns. rif. NP 0015 dal titolo "NITROOXYDERATIVES OF CARVEDILOL AND OTHER BETA BLOCKERS AD ANTIHYPERTENSIVE DRUGS" - 5 Documenti: Canada/Assignment; New Zealand/Request under Section 23 (3); USA/Assignment e Declaration; South Africa/Assignment e il testo del brevetto.

La invito a restituirmi detta documentazione debitamente firmata entro 8 giorni dalla data di Suo ricevimento della presente.

Trasmetto inoltre copia di questa lettera e dell'allegata documentazione anche al Suo legale, affinché possa anch'egli esaminarla.

Coi migliori saluti.


(Avv. Maria Teresa Noro)

All.: come nel testo

Avviso di ricevimento

☒ Raccomandata ☐ Paccon

☐ Assicurata

Luro

Data di spedizione

9/5/06

Dall'ufficio postale di

129080415473
Numero

Destinatario DOT. PIRO DEL SOLDATO

Via ENRICO TOTI, 22

C.A.P. 20052 Località MONZA (MI)

ES 1204 3

No del MV
Firma per esteso del ricevente
(Nome e Cognome)

16/5/06
Data

Firma dell'incaricato alla distribuzione

Logo dell'Ufficio di distribuzione

☐ Consegna effettuata ai sensi dell'art. 33 D.M. 09/04/01
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• Sottoscrizione rifiutata

Posteitaliane

Mod. 22 R Cod. W01E0C - Ed. 10/01

Arretrazione **RACCOMANDATA**

RICEVUTA

È vietato introdurre denaro e valori nella raccomandata. Poste Italiane S.p.A. non ne risponde.

Si prega di compilare a cura del mittente a macchina o in stampatello

DESTINATARIO	<u>DOT. PIRO DEL SOLDATO</u>		N. CIV. PROV.
	<u>VIA ENRICO TOTI</u>		
	<u>22</u>		
	COMUNE		
MITTENTE	<u>Aw. MARIA TERESA NORO</u>		N. CIV. PROV.
	<u>Via Regina Margherita, 41 - 20122 MILANO</u>		
	<u>Tel. 02-550.111.00 (r.a.)</u>		
	<u>Fax 02-5510369</u>		
C.A.P.		COMUNE	
SERVIZI ACCESSORI RICHIESTI		Via aerea	
Contrassegno la casella intestata		Assegno	

Usare
(semplice manuale)

TASSE

Avv. Maria Teresa Noro

Egregio Signor
dott. Piero del Soldato
Via Enrico Toti 22
MONZA

*Viale Regina Margherita 11
20122 Milano
Tel. 02.550.411.33
Fax 02.55.18.369*

c, per conoscenza
RACCOMANDATA A MANO
Egregio Signor
Avvocato Fabrizio Conte
Via Freguglia 8/a
20122 - MILANO

Milano, 25 maggio 2006
RACCOMANDATA A.R.

Egregio dott. Del Soldato,

faccio seguito alla mia lettera raccomandata del 9 maggio, pervenutaLe il successivo 16 maggio, per trasmetterle nuovamente per la firma la seguente documentazione:

- 1) ns. rif. NP 0015 dal titolo "NITROOXYDERIVATIVES OF CARVEDILOL AND OTHER BETA BLOCKERS AD ANTIHYPERTENSIVE DRUGS" - 5 Documenti: Canada/Assignment; New Zealand/Request under Section 23 (3); USA/Assignment e Declaration; South Africa/Assignment e il testo del brevetto.

Le rinnovo l'invito a restituirmi detta documentazione debitamente firmata entro 8 giorni dalla data di Suo ricevimento della presente.

Trasmetto inoltre copia di questa lettera e dell'allegata documentazione anche al Suo legale, affinché possa anch'egli esaminarla.

Coi migliori saluti.


(Avv. Maria Teresa Noro)

All.: come nel testo

22 esplosione

Posteitaliane

Mod. 22 R. Cod. 00150F Ed. 10/01

Accettazione **RACCOMANDATA**

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	VIA / PIAZZA			PROV.
	C.A.P.	COMUNE		
	MITTENTE	AVV. MARIA TERESA NORO		
	VIA / PIAZZA	Viale Regina Margherita, 41 - 20122 MILANO		
		Tel. 02-550.111.99 (r.a.)		
		Fax 02-5516369		
	C.A.P.	COMUNE		
SERVIZI ACCESSORI RICHIESTI		<input type="checkbox"/> Via aerea <input type="checkbox"/> A.R.		
Contassegnare la cassa interessata		<input type="checkbox"/> Assegno €		(in cifre)

Vallo
(accettazione normale)

TASSE

Avviso di ricevimento

☒ Raccomandata ☐ Fucile
☐ Assicurata Euro

Data di spedizione 26/05/06 Dall'ufficio postale di MI 25

Destinatario DOCT. PIERO DEL SOLDATO
Via ENRICO TOTI, 22
C.A.P. Località MONZA

Es. 0014 L1

Firma per esteso del ricevente
(Nome e Cognome)

Data

Firma dell'incaricato alla distribuzione

Firma dell'ufficio
di distribuzione

☐ Consegna effettuata ai sensi dell'art. 30 D.M. 28.04.01
- Invii multipli a un unico destinatario
- Restituzione rifiutata

Docket No. _____



ARENT FOX PLLC

Declaration and Power of Attorney for U.S. Patent Application

As a below named inventor, I hereby declare that:

My residence, post office address and citizenship are as stated below my name.

I believe I am the original, first and sole inventor (if only one name is listed below) or an original, first and joint inventor (if plural names are listed below) of the subject matter, which is claimed and for which a patent is sought on the invention entitled

(Insert Title) **NITROOXYDERIVATIVES OF CARVEDILOL AND OTHER BETA BLOCKERS AS ANTIHYPERTENSIVE DRUGS**

the specification of which is attached hereto unless the following box is checked:

☒ was filed on December 1, 2004 As PCT International Application
Number PCT/EP2004/013683 and was amended on _____
and/or was filed on _____ As U.S. Patent Application
Number _____ and was amended on _____

I hereby state that I have reviewed and understand the contents of the above-identified specification, including the claim(s), as amended by any amendment referred to above.

I acknowledge the duty to disclose information which is material to patentability as defined in 37 C.F.R. §1.56.

I hereby claim foreign priority benefits under 35 U.S.C. §119(a)-(d) or §365(b) of any foreign application(s) for patent or inventor's certificate, or §365(a) of any PCT International application which designated at least one country other than the United States, listed below and have also identified below any foreign application for patent or inventor's certificate or PCT International Application having a filing date before that of the application(s) for which priority is claimed:

(List prior foreign applications)	03104484.5 (Number)	Europe (Country)	02/12/2003 (Day/Month/Year Filed)	Priority Claimed <input checked="" type="checkbox"/> Yes <input type="checkbox"/> No
	_____ (Number)	_____ (Country)	_____ (Day/Month/Year Filed)	<input type="checkbox"/> Yes <input type="checkbox"/> No
	_____ (Number)	_____ (Country)	_____ (Day/Month/Year Filed)	<input type="checkbox"/> Yes <input type="checkbox"/> No

I hereby claim the benefit under 35 U.S.C. §119(e) of any United States provisional application(s) listed below.

_____ (Application Number)	_____ (Filing Date)
_____ (Application Number)	_____ (Filing Date)

☐ See attached list for additional prior foreign or provisional applications.

I hereby claim the benefit under 35 U.S.C. §120 of any United States application(s) or §365(c) of any PCT International application(s) designating the United States of America listed below and, insofar as the subject matter of each of the claims of this application is not disclosed in the prior application(s) (U.S. or PCT) in the manner provided by the first paragraph of 35, U.S.C. §112, I acknowledge the duty to disclose information which is material to patentability as defined in 37 C.F.R. §1.56 which became available between the filing date of the prior application and the national or PCT International filing date of this application.

(List prior U.S. Applications or PCT International applications designating the U.S.)	_____ (Application Serial No.)	_____ (Filing Date)	_____ (Status) (patented, pending, abandoned)
	_____ (Application Serial No.)	_____ (Filing Date)	_____ (Status) (patented, pending, abandoned)

Power of Attorney: I hereby appoint all registered practitioners associated with the firm of Arent Fox, Customer Number **004372**, to prosecute this application and to transact all business in the Patent and Trademark Office connected therewith.

Please direct all communications to the following address: Customer No. **004372**
ARENT FOX PLLC
1050 Connecticut Avenue, N.W., Suite 400
Washington, D.C. 20036-5339
Telephone No. (202) 857-6000; Facsimile No. (202) 638-4810

The undersigned hereby authorizes the U.S. attorneys named herein to accept and follow instructions from the undersigned's assignee, if any, and/or, if the undersigned is not a resident of the United States, the undersigned's domestic attorney, patent attorney or patent agent, as to any action to be taken in the Patent and Trademark Office regarding this application without direct communication between the U.S. attorneys and the undersigned. In the event of a change in the person(s) from whom instructions may be taken, the U.S. attorneys named herein will be so notified by the undersigned

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further, that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Full name of sole or first inventor DEL SOLDATO Piero

Inventor's signature _____ Date _____

Residence Via E. Toti, 22 - 20052 Monza (Milano)(Italy)

Citizenship Italian

Post Office Address Same as above

Full name of second inventor BENEDINI Francesca

Inventor's signature Francesca Benedini Apr 6, 2006
Date

Residence Via Padova 286 - 20132 Milano (Italy)

Citizenship Italian

Post Office Address Same as above

Full name of third inventor ONGINI Ennio

Inventor's signature Ennio Ongini Apr 6, 2006
Date

Residence Via Fratelli Cervi, Residenza Campo - 20090 Segrate (Milano)(Italy)

Citizenship Italian

Post Office Address Same as above

Full name of fourth inventor _____

Inventor's signature _____ Date _____

Residence _____

Citizenship _____

Post Office Address _____

Full name of fifth inventor _____

Inventor's signature _____ Date _____

Residence _____

Citizenship _____

Post Office Address _____

Full name of sixth inventor _____

Inventor's signature _____ Date _____

Residence _____

Citizenship _____

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